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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,032	04/13/2004	Robert H. Kummer JR.	F-791-O1	3383

919 7590 04/23/2010
PITNEY BOWES INC.
35 WATERVIEW DRIVE
MSC 26-22
SHELTON, CT 06484-3000

EXAMINER

WU, RUTAO

ART UNIT	PAPER NUMBER
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3628

NOTIFICATION DATE	DELIVERY MODE
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04/23/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. KUMMER, JR., LINDA S. LIN,
LYNN W. D'AMICO, and WESLEY A. KIRSCHNER

Appeal 2009-006280
Application 10/823,032
Technology Center 3600

Decided: April 21, 2010

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-19 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to a system and method to remotely enable and disable features in a mailing system. (Spec. [0008]). Claim 1, reproduced below with some numbering in brackets added, is representative of the subject matter of appeal.

1. A method for a mailing machine to change operational features comprising:
 - establishing a communication link with a remote data center via a network;
 - receiving from the remote data center, via the communication link, a directory file, the directory file including an indication of all operational features that should be enabled within the mailing machine, each of the operational features having at least one associated operating file required to implement the operational feature;
 - determining if an operating file stored in a memory of the mailing machine is not associated with an operational feature indicated in the directory file; and
 - [1] deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file,wherein deletion of any operating file stored in the memory of the mailing machine that is not associated with an operational feature

indicated in the directory file disables an operational feature with which the deleted operating file is associated.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Eskandari	US 2002/0133471 A1	Sep. 19, 2002
Choksi	US 6,477,243 B1	Nov. 5, 2002
Shaw	US 2002/0176111 A1	Nov. 28, 2002
Montgomery	US 2003/0101148 A1	May 29, 2003

The following rejections are before us for review:

1. Claims 1 and 8 are rejected under 35 U.S.C. § 102(b) as anticipated by Eskandari.
2. Claims 2, 4-5, 9, 11-12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Eskandari.
3. Claims 3 and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Eskandari and Choksi.
4. Claims 6, 13, 15-16 and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Eskandari and Montgomery.
5. Claims 7 and 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Eskandari and Shaw.
6. Claims 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Eskandari, Montgomery, and Choksi.
7. Claims 19 is rejected under 35 U.S.C. § 103(a) as unpatentable over Eskandari, Montgomery and Shaw.

THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether Eskandari discloses claim limitation [1] as identified in claim 1 above.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:¹

FF1. Eskandari has disclosed the configuration enablement of a franking system (Title).

FF2. Eskandari has disclosed customizing a system having a plurality of operating features. At least one selected operating feature is enabled by selecting at least one secondary parameter from a predefined list of secondary parameters. A compilation of parameters is installed in the customized system and enables the selected operating features to be used (Abstract).

FF3. Eskandari at paragraphs [0061] and [0062] discloses:

[0061] In another embodiment, a currently enabled operating feature 32 can be selected to be disabled. The independent parameter 470 representing the enabled operating feature 32 can be removed from the franking system's parameter set 458. The secondary parameters 472 and dependent parameters 476 are selected based on the updated parameter set 458. The new authorization code 14 is generated based on the updated parameter set 458, and is entered into the franking

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

system 11. The enabled operating feature 32 is then disabled, and unavailable for use in the franking system 11.

[0062] In a further embodiment, the operating features 12 of the current franking system 11 can be saved. When an update is to be accomplished, new operating features 30 are added to the saved operating features, and operating features to be removed 24 are removed from the saved operating features. The updated saved operating features can be the parameter set 458 of independent parameters 470. The parameter set 458 can be used, along with the associated secondary parameters 472 and dependent parameters 476, to generate a new authorization code 14, which can be entered into the franking system 11.

FF4. Eskandari at [0061] discloses that independent parameter 470 representing operating feature 32 can be removed from the franking systems parameter set 458.

FF5. Eskandari at [0062] discloses that operating features 12 of the current franking system can be saved and that operating features to be removed 24 are removed from the saved operating features.

FF6. Eskandari at Fig. 1 (item 360), [0031], [0042], [0061] and [0062] does not specifically disclose deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file.

PRINCIPLES OF LAW

Principles of Law Relating Claim Construction

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be

interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art” *id.* at 415-16.

ANALYSIS

The Appellants argue that the rejection of claim 1 is improper because “in Eskandari an operating feature is simply disabled” and that there is no disclosure of claim limitation [1] (Br. 7). The Appellants argue that “[t]here is a difference between disabling a feature, i.e., making it non-operational, and deleting operational files stored in memory.” The Appellants also argue that Eskandari at paragraph [0035] discloses that the system can be upgraded or downgraded at anytime without additional software showing that no files were deleted from the system (Br. 7). The Appellants also argue that removing parameter 470 from the parameter set 458 does not delete an operating file (Br. 8).

In contrast, the Examiner has determined that Eskandari discloses the cited claim limitation [1] at paragraphs [0060] and [0061] (Ans. 13).

We agree with the Appellants. Claim 1 includes claim limitation [1] which recites:

[1] *deleting any operating files stored in the memory of the mailing machine* that are not associated with an operational feature indicated in the directory file (Claim 1, emphasis added).

Eskandari at [0061] discloses that independent parameter 470 representing operating feature 32 can be removed from the *franking systems parameter set 458* (FF4) but the franking system parameter set 458 has not shown to be “*any operating files stored in the memory of the mailing*

machine that are not associated with an operational feature indicated in the directory file.” Similarly, Eskandari at [0062] discloses that operating features 12 of the current franking system can be saved and that operating features to be removed 24 are removed from the saved operating features (FF5) but it not specifically disclosed that the removal is not from another parameter set or that is “*any operating files stored in the memory of the mailing machine* that are not associated with an operational feature indicated in the directory file” as claimed. Thus, Eskandari at [0061] and [0062] does not specifically disclose deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file (FF6). Note that while Eskandari discloses that an operating feature can be removed from the franking systems parameter set 458 (FF4) that this is not shown to necessarily include all the memory areas of the mailing machine. While paragraph [0062] does disclose removal of saved operating features, the removal maybe from a specific parameter set and again does not necessarily include all memory areas of the mailing machine. The Examiner has not asserted that such a feature of claim limitation [1] is inherent in the reference and it does not appear that such a position can be established beyond probabilities or possibilities. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted). For these

reasons the rejection of claim 1 and its dependent claims is not sustained. The Appellants have provided similar arguments for claim 8 and 15, which contain a similar limitation, and the rejection of these claims and their dependent claims is not sustained for the same reasons above.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1 and 8 under 35 U.S.C. § 102(b) as anticipated by Eskandari.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 2, 4-5, 9, 11-12 under 35 U.S.C. § 103(a) as unpatentable over Eskandari.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 3 and 10 under 35 U.S.C. § 103(a) as unpatentable over Eskandari and Choksi.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 6, 13, 15-16 and 18 under 35 U.S.C. § 103(a) as unpatentable over Eskandari and Montgomery.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 7 and 14 under 35 U.S.C. § 103(a) as unpatentable over Eskandari and Shaw.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 17 under 35 U.S.C. § 103(a) as unpatentable over Eskandari, Montgomery, and Choksi.

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We conclude that Appellants have shown that the Examiner erred in rejecting claim 19 under 35 U.S.C. § 103(a) as unpatentable over Eskandari, Montgomery and Shaw.

DECISION

The Examiner's rejection of claims 1-19 is reversed.

REVERSED

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JRG